

REMARKS

I. Introduction

Claims 1 to 10 and 19 to 21 are currently pending in this application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1 to 4 and 21 Under 35 U.S.C. § 102(b)

Claims 1 to 4 and 21 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,028,038 ("de Fontenay"). Applicant respectfully submits that de Fontenay does not anticipate claims 1 to 4 and 21 for the following reasons.

As an initial matter, Applicant notes an inconsistency between the Office Action summary, which indicates that claims 19 and 20 are rejected, and page 1 of the Office Action, which indicates that claims 1 to 4 and 21 are rejected. Applicant proceeds on the basis that claims 19 and 20 are also rejected given that they are mentioned on the bottom of the page 1 of the Office Action, however, clarification in this regard is respectfully requested.

Claim 1 relates to a hydraulic bearing. Claim 1 recites that the hydraulic bearing includes a journal bearing and a supporting bearing which are joined by a spring body made of a rubber elastic material and border on at least one working space and at least one compensating space. Claim 1 further recites that the working space and the compensating space are each filled with a damping fluid and communicate through a damping device in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it. Claim 1 further recites that the damping device (6) is formed by a partition (7) between the working space (4) and the compensating space (5) and that the partition (7) has at least one radially extending damping channel (8).

Claim 21 relates to a hydraulic bearing. Claim 21 recites that the hydraulic bearing includes a journal bearing and a supporting bearing which are joined by a spring body made of a rubber elastic material and border on at least one working space and at least one compensating space. Claim 21 further recites that the working space and the compensating space are each filled with a damping fluid and communicate through a damping device in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it. Claim 21 further recites that the

hydraulic bearing is configured such that in response to low-frequency high amplitude vibrations in an axial direction of the hydraulic bearing the damping device has damping fluid flowing back and forth through it in phase opposition to the induced vibrations.

De Fontenay purportedly relates to an elastic vibration isolation mounting with integral hydraulic damping and a rigid partition with an adjustable passage for conducting fluid. De Fontenay state that the elastic anti-vibration isolation mounting acts such that the inertia of the column of damping liquid provides a damping function which has desirable damping characteristics. See col. 12, lines 44 to 47. De Fontenay further state that the mounting increases the apparent rigidity in a very limited range of rather low frequencies by means of a column of liquid which is very long in relation to its cross section. See col. 1, lines 14 to 19. The resonance of this column is stated to counteract large amplitude displacements but not deleteriously affect the elastic filtering of higher frequencies. See col. 1, lines 19 to 22. Nowhere, however, does de Fontenay disclose, or even suggest, that in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claims 1 and 21. Further, de Fontenay does not disclose, or even suggest, that the hydraulic bearing is configured such that in response to low-frequency high amplitude vibrations in an axial direction of the hydraulic bearing the damping device has damping fluid flowing back and forth through it in phase opposition to the induced vibrations, as recited in claim 21.

As detailed in the Specification, when the journal bearing (1) is radially displaced toward the supporting bearing (2), the volume of the fluid pocket (9) in the working space (4) is reduced, with the displaced portion of the fluid passing through partition (7) and being accommodated in the compensating space (12). See the Specification at p. 4, lines 10 to 15. The Office Action admits that de Fontenay does not disclose a working space having at least one variable volume fluid pocket extending in the axial direction but does not explain where de Fontenay discloses that mounting element has damping fluid flowing through it in response to relative radial displacement of the journal bearing and the supporting bearing, as recited in claims 1 and 21. As indicated above, it is the change in volume of the fluid pocket (9), which the Office Action admits is missing in de Fontenay, that results in the flow of damping. Given the shape of working space (5) in de Fontenay it is possible that radial displacements of elements 3 and 4 distorts spring body 2 without causing a change in the working space (5) volume, thus not causing damping fluid flowing through channel 8, 9.

To the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” See M.P.E.P. § 2112; emphasis in original; and see, *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Nowhere does the Examiner rely on technical reasoning to support its conclusion that fluid necessarily flows between spaces 5 and 6 in response to a relative radial displacement of elements 3 and 4.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that de Fontenay does not disclose, or even suggest, all of the limitations of claims 1 and 21. Therefore, it is respectfully submitted that de Fontenay does not anticipate claims 1 and 21. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claims 1 and 21 are respectfully requested.

As for claims 2 to 4, 19 and 20, which ultimately depend on claim 1 and therefore include all of the limitations of claim 1, Applicant respectfully submits that these claims are patentable for at least the same reasons provided above in support of the patentability of claim 1. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claims 2 to 10, 19 and 20 are respectfully requested.

III. Rejection of Claims 5 to 10 Under 35 U.S.C. § 103(a)

Claims 5 to 10 were rejected under 35 U.S.C. § 103(a) as obvious over the combination of de Fontenay and U.S. Patent No. 5,386,973 ("Brenner et al."). Applicant respectfully submits that claims 5 to 10 are patentable over the combination of de Fontenay and Brenner et al. for at least the following reasons.

Brenner et al. purportedly relate to an elastomeric bearing. Brenner et al. state that the bearing includes at least two fastening parts 7 and 8 connected to one another by means of an elastomer spring 6. Inside the elastomeric bearing at least two damping devices are stated to work essentially independent of one another. See col. 4, lines 4 to 12. The first independent damping device is stated to include chambers 3a and 3b, which are stated to communicate via passage 4. The second independent damping device is stated to include chambers 1a and 1b, which are stated to be separated by partition 10 having passage 2. The first independent damping device is stated to dampen in the radial direction and the second independent damping device is stated to dampen in the longitudinal direction. See col. 4, lines 17 to 40. Accordingly, fluid only flows through partition 10 (damping device) in the second damping device when parts 7 or 8 are excited in a longitudinal direction.

As indicated above, the Office Action admits that de Fontenay does not disclose a working space having at least one variable volume fluid pocket extending in the axial direction, wherein fluid flows back and forth from and to said working space and said compensating space in response to radial displacement of the journal bearing and the supporting bearing. Further, Brenner et al. do not disclose, or even suggest, a working space having at least one variable volume fluid pocket, wherein relative **radial displacement** of the journal bearing and the supporting bearing with respect to one another, damping fluid flows from the fluid pocket through the damping device. As indicated above, only the second independent damping device of Brenner et al., responsive to longitudinal (not radial) vibrations, is stated to include chambers 1a and 1b, which are stated to be separated by partition 10 having passage 2. Therefore, nowhere does the combination of de Fontenay and Brenner et al. disclose, or even suggest, that in response to relative **radial displacement** of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claims 1, 5, 6 and 7. Claims 5 to 7 have been amended so as to be placed in independent form. Claims 8 to 10 depend from claim 1 and therefore include all of the limitations of claim 1. Therefore, the combination of de

Fontenay and Brenner et al. does not disclose, or even suggest, all of the limitations of claims 5 to 10.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of de Fontenay and Brenner et al. does not disclose all of the limitations of claims 5 to 10. Therefore, Applicant respectfully submits that the combination of de Fontenay and Brenner et al. does not render obvious claims 5 to 10.

The Office Action admits that de Fontenay does not disclose a working space having at least one variable volume fluid pocket extending in the axial direction but alleges that Brenner et al. disclose such a fluid pocket. The Office Action merely states that Brenner et al. disclose a fluid pocket and does not even allege that it would have been obvious to combine de Fontenay and Brenner et al. Nor does the Office Action proffer any motivation or suggestion for making such a combination. Therefore, Applicant respectfully submits that the Examiner fails to present a *prima facie* case of obviousness and withdrawal of this rejection is therefore respectfully requested.

Notwithstanding the above, Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art to modify the mounting of de Fontenay to include the fluid pocket of de Fontenay. It is respectfully submitted that the cases of *In re Fine*, *supra*, and *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that generalized assertions that it would have been obvious to modify or combine references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action, to the extent it is interpreted to indicate that a combination of de Fontenay and Brenner et al. render the present claims obvious, reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness

rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever to support a proper obviousness finding. None of the patents or publications relied upon mention or refer to a motivation for combining de Fontenay and Brenner et al.

Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation, outside of Applicant's application, for modifying or combining the references to provide the claimed subject matter.

The Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

In view of all of the foregoing, it is respectfully submitted that the combination of de Fontenay and Brenner et al. does not render obvious claims 5 to 10. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 5 to 10 are respectfully requested.

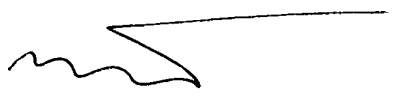
IV. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: March 16, 2005



KENYON & KENYON

By: Richard M. Rosati
Reg. No. 31,792

One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646